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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/880,036 | 06/14/2001 | Hiroyuki Sekitani | 010734 | 5953 |
| 38834 | 7590 | 01/05/2005 | EXAMINER | |
| WESTERMAN, HATTORI, DANIELS & ADRIAN, LLP 1250 CONNECTICUT AVENUE, NW SUITE 700 WASHINGTON, DC 20036 | | | FADOK, MARK A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3625 | |

DATE MAILED: 01/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/880,036

Applicant(s)

SEKITANI, HIROYUKI

Examiner

Mark Fadok

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 October 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Reply

The examiner is in receipt of applicants response to office action mailed 9/13/2004, which was received 10/28/2004. Acknowledgement is made that no amendments were made to the claims leaving claims 1-3 as pending in the instant application. The examiner has carefully considered the applicant's remarks, but did not find them to be persuasive. Therefore the previous rejection is restated below:

Examiner's Note

Examiner has cited particular columns and line numbers or figures in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant, in preparing the responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 and 2 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ng (US 5,445,347) in view of Smith et al (US 5,931,877).

In regards to claim 1, Ng discloses a part retrieving system for production machines utilizing a network, the system being characterized in that the system comprises a part database (col 8, lines 10-15) and

a terminal connected to the part database via a communication network for bi-directional communications with the part database (col 8, lines 17-25 and FIG 5),

said part database has information on parts accumulated therein (col 8, lines 15-40),

the parts constituting each of production machines having different specifications (Col 8, technical data and multiple production items, i.e. items 14 and 16). , and

said terminal comprises part information requesting means for requesting said part database to transmit the part information (col 8, lines 15-35),

Ng teaches requesting parts data information from a remote database and interactively communicating, but does not specifically mention that the data is stored at the users location (col 8, lines 20-25). Smith teaches storing information in an intermediate location at the users site (col 6, lines 30-37). It would have been obvious to a person having ordinary skill in the art to include in Ng, the local storage capability as described by Smith, because the requested information will require a download of a significant amount of data, so having the information local as is notoriously well known, increases the speed at which the data can be accessed and manipulated, thus making the system more efficient. and

retrieval means for retrieving parts from the stored part information depending on retrieval conditions (col 8, lines 20-25).

In regards to claim 2, Ng discloses the system being characterized in that said part information requesting means transmits information including identification information on the individual production machines (abstract, train 18 and cars 16 and 14),

said database extracts, in response to said transmission request, information on parts concerning a production machine specified by said identification information (Col 8, lines 25-35, parts cross reference) and

transmits the information as machine-specific part information comprising a group of pieces of part information on a specific production machine (col 8, lines 25-31).

Claim 3 rejected under 35 U.S.C. 103(a) as being unpatentable over Ng as in view of Smith and further in view of Official Notice.

In regards to claim 3, Ng teaches selection means and graphics displays (see col 8), but does not specifically mention that there is a menu provided for selection purposes. It was old and well known in the art at the time of the invention to provide selection menus. It would have been obvious to a person having ordinary skill in the art to include in Ng, providing selection menus for the different parts, because this was a notoriously well known method for providing a means for less advanced individuals to get to required information, thus allowing less trained individuals to use the system.

Response to Arguments

Applicant's arguments filed 10/28/2004 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., polling and order of retrieval of information) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In regards to claim 1, applicant argues that neither Ng nor Smith disclose or suggest "said terminal comprises part information requesting means for requesting said part database to transmit the part information". The examiner disagrees and directs the applicant's attention to the previously cited location and also fig 5 and Col 7, lines 60-67, which disclose a personal computer capable of accessing a parts database (spare parts item 90) and receiving the appropriate information.

In regards to claim 2, applicant argues that that the NSIU fails to transmit information on individual production machines. The examiner disagrees and directs the applicant's attention to system 86, which is an expert system capable of sending and receiving information to aid in the proper maintenance of the equipment (individual trains).

In regards to claim 3, applicant argues that the examiner failed to consider the display of specific information found in the claim. The examiner disagrees and notes that the specific feature was considered and that selection menus as stated by the examiner include the specific information that is being recited in claim 3. The examiner also directs the applicant's attention to the fact that all the trains are serialized and contain specific information regarding each train, therefore it would be beneficial for the display to include a listing to a specific machine so that the maintenance operator can get the appropriate information specific to the individual maglev train.

Further, a "traverse" is a denial of an opposing party's allegations of fact. The Examiner respectfully submits that applicants' arguments and comments

Art Unit: 3625

do not appear to traverse what Examiner regards as knowledge that would have been generally available to one of ordinary skill in the art at the time the invention was made. Even if one were to interpret applicants' arguments and comments as constituting a traverse, applicants' arguments and comments do not appear to constitute an adequate traverse because applicant has not specifically pointed out the supposed errors in the examiner's action, which would include stating why the noticed fact is not considered to be common knowledge or well-known in the art. 27 CFR 1.104(d)(2), MPEP 707.07(a). An adequate traverse must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying Examiner's notice of what is well known to one of ordinary skill in the art. In re Boon, 439 F.2d 724, 728, 169 USPQ 231, 234 (CCPA1971).

If applicant does not seasonably traverse the well-known statement during examination, then the object of the well-known statement is taken to be admitted prior art. In re Chevenard, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the examiner as provided motivation that is generally available to one of ordinary skill in the art, but also directs the applicant's attention to Ng col 8, lines 5-9.

The applicant further states in a footnote on page 1 that the examiner mistakenly stated claims 2 and 3 instead of claims 1 and 2 in the preface to the rejection on page 2 of the office action. This oversight has been corrected above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **(703) 605-4252**. The examiner can normally be reached Monday thru Thursday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Wynn Coggins** can be reached on **(703) 308-1344**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 308-1113**.

Any response to this action should be mailed to:

Commissioner for Patents

P.O. Box 1450

Alexandria, Va. 22313-1450

or faxed to:

(703) 872-9306 [Official communications; including
After Final communications labeled
"Box AF"]

(703) 746-7206 [Informal/Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th floor receptionist.

Art Unit: 3625

A handwritten signature in black ink, appearing to read 'Mark Fadok', with a stylized, flowing script.

Mark Fadok

Patent Examiner